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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/551,863

09/30/2005

Barbara Dold

05-640

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BACHMAN & LAPOINTE, P.C.

900 CHAPEL STREET

SUITE 1201

NEW HAVEN, CT 06510

EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

05/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/551,863 | DOLD, BARBARA | |
| | Examiner | Art Unit | |
| | GINA C. YU | 1611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-62 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 33-62 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/30/05, 5/2/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 51 requires a preparation of its base claim avoid of wax, fat and oil. the claim is rendered vague and indefinite because claim 33, the base claim on which claim 51 depends, requires volatile silicone oil.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33, 39, 40, 42-50, 52, 54-56, 60, 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Leverett (US 6132739).

Leverett discloses a water-in-oil emulsion makeup foundation comprising an aqueous phase comprising C10 polycarbomyl polyglyceryl ester, a polyurethane copolymer; an emulsified phase comprising cyclomethicone (volatile silicone), metal oxides (pigments), and optionally acrylates copolymer suspending agent (filler). See example 2; instant claims 33, 39, 40, 42,47, 48, 49, 60, 61. The composition also

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contains glycerin humectant, meeting instant claims 43, 44, 50. The humectant and plant extracts as antioxidant meet instant claims 50, 54, and 55. The volatile silicone oil phase contains dimethicone copolyol emulsifier, meeting instant claim 52. The reference teaches the aqueous phase containing film-forming polymer is individually mixed until homogenous before mixed with other phases, thus meeting instant claim 56. Applicant's "light diffusing pigments" of claim 45 and 46 are considered met by the prior art product which contains yellow, black, and red iron oxides coated with magnesium myristate.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leverett as applied to claims 33, 39, 40, 42-50, 52, 54-56, 60, 61 as above, and further in view of the teaching of the reference.

Although Example 2 of the reference uses 1 % by weight of the hydrophilic film forming copolymer, the reference teaches up to 8 wt % of hydrophilic film former can be used. See col. 5, lines 10-16; instant claims 58, 59. The prior art makeup foundation is said to have enhanced transfer resistance.

Claims 34-38, 41, 53, 57, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leverett as applied to claims 33, 39, 40, 42-50, 52, 54-56, 58-61 as above, and further in view of Hanna et al. (US 5879668).

Leverett teaches polyurethanes, acrylates, and methacrylate are among the suitable hydrophilic film formers to make the W/O transfer-free makeup foundation, and the reference generally teaches the film-formers may be combined. The reference does not does not particularly mention combining polyurethane and acrylate polymers.

Hanna also teaches a waterproof, long wear and transfer resistance O/W emulsion cosmetics comprising water-soluble or -dispersible film-forming polymers. Particularly mentioned are polycarbamyl polyglycol ester (a polyurethane) or ammonium acrylate copolymer, sodium polymethylacrylate, etc. See col. 5, lines 4 - 22. The reference states, "mixtures of such polymers may be used" and also teaches acrylic polyurethanes. Using the water-soluble or dispersible polymers in the range of 0.1-10 wt % is taught. Useful emulsifiers for the prior art emulsion include glyceryl stearate, alkyl dimethicone copolyol, polyglyceryl -4 isostearate, etc. See col. 4, lines 28 – 49; instant claim 53. Hanna further teaches adding light diffusing particles (nylon-12 particles) for camouflaging fine lines of skin and improving the skin feel when the product is applied to the skin. See col. 6, lines 3 – 13.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teachings of Leverett by selecting the water-soluble or water-dispersible film-forming copolymers, i.e., polycarbamyl polyglycol ester, or ammonium acrylate copolymer, and sodium polymethylacrylate, among the suitable

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film-formers as motivated by Hanna, because Leverett teaches polyurethanes and acrylate polymers are suitable film-formers for the invention; and Hanna specifically teaches a combination of polyurethanes with acrylate polymers or acrylic polyurethane copolymer to make a transfer-resistant make-up in a form of water-in-oil emulsion. The skilled artisan would have had a reasonable expectation of successfully producing a stable transfer-resistant W/O cosmetic with a similar or enhanced efficacy.

With respect to the process claim of claim 62, it is well settled in patent law that selection of any order of mixing ingredients is *prima facie* obvious. See In re Gibson, 39 F.2d 975, 5 USPQ 230 (CCPA 1930). See also Ex parte Rubin, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render *prima facie* obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). In this case, Leverett teaches adding hydrophilic film formers in an aqueous phase which forms the interior water phase before the aqueous phase is mixed with the volatile silicone phase comprising the pigments. The instant claim requires thickeners and film-forming polymers be added after the homogenization of the volatile silicone and water phase, which also results in a W/O emulsion comprising the polymers in the water phase. In view of the holding of the precedents, altering the sequence of the adding the ingredients from the prior art is *prima facie* obvious.

Conclusion

No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Friday, from 9:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gina C. Yu/
Primary Examiner, Art Unit 1611